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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/706,219	11/12/2003	Bindu Rama Rao	14321US03	6320
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EXAMINER KENDALL, CHUCK O				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary**Application No.**

10/706,219

Applicant(s)

RAO, BINDU RAMA

Examiner

CHUCK O. KENDALL

Art Unit

2192

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12/29/08.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This action is in response to application filed 10/29/08.
2. Claims 1 – 29 have been amended.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1 -29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johansson et al. (US Patent 5,418,837) in view of Thurston US 20030217358 A1.

Claims 1 and 11:

Johansson discloses an updatable electronic device including:

a memory including at least one of firmware and software (e.g. see Fig. 1A, items 15, and associated text);

an interface for communicatively coupling to a removable electronic memory device (e.g. see Fig. 1A, item 20, and associated text);

and updating of the at least a portion of the at least one of firmware and software (Fig. 1A, item 22, and associated text).

Johansson doesn't expressly disclose at least one firmware component, functioning to update at least a portion of at least one of firmware and software and wherein using update information stored in the memory and wherein the removable electronic memory device comprises metadata information associated with the stored update information.

However, Thurston in an analogous art and similar configuration discloses, "... firmware update utility 302 after receiving the firmware update package 108a extracts the metadata included in the header 400 and list of properties package 402..."[0051].

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Johansson and Thurston, because it would enable updating the associated information as suggested by Thurston above.

Claim 2:

Johansson discloses the device of claim 1 where the at least one firmware component comprises: an update agent for updating the at least a

portion of the at least one of firmware and software, the update agent using the update information and the information related to the updating of the at least one of firmware and software ("the routine then changes all the software in the mobile terminal from information provided in the upgrading software stored in the SUM card", col. 7, lines 13-16, Fig. 3, and associated text);

Claim 3:

Johansson discloses the device of claim 1 further including: a communication interface for receiving the update information (Fig. 1A, item 20, and associated text).

Claim 4:

Johansson discloses the device of claim 3 but does not disclose where the communication interface is a wireless communication interface. In an analogous art of updating mobile phones, O'Neil discloses in an analogous art and similar configuration updating using wireless communication (Figure 1A, 112 and all associated text).

Therefore, it would have been obvious to one with ordinary skill in the art at the time of the invention to wirelessly update the device as claimed in

order to ensure timely updates through the air as suggested by O'Neil above.

Claim 5:

Johansson discloses the device of claim 2 where the update information comprises an update package containing a set of instructions executable by the update agent for updating the at least a portion of the at least one firmware and software ("upgrading data" may be stored in the SUM card, col. 4, lines 7-14, e.g. see Fig. 213, and associated text).

Claim 6:

Johansson discloses the device of claim 1 where the metadata information ~~related to~~ associated with the stored update information for [Thurston, 0051] information related to the updating of the at least one firmware and software comprises at least one of a cyclic redundancy check (CRC), a location in a file system, a memory address, a status flag, and new firmware ("identification data telling ... if the SUM card is designed for upgrading software, adding new features... ", col. 4, line 3-6, e.g. see Fig. 3, step 110, and associated text).

Claim 7:

Johansson discloses the device of claim 1 where the metadata information ~~related to~~ associated with the stored update information for updating of the at least one firmware and software comprises an indication of the availability of update information for the at least one of a firmware and software (e.g. see Fig. 3, and associated text, col. 7, lines 6-7 states "if the SUM card is valid for upgrading, the upgrading functions would be displayed on the display...").

Claim 8:

Johansson discloses the device of claim 1 where metadata information ~~related to~~ associated with the stored update information the information related to the updating of the at least one firmware and software comprises an indication of the success of an update of the at least one of firmware and software (Fig. 3, item 120).

Claim 9:

Johansson discloses the device of claim 1 where metadata information ~~related to~~ associated with the stored update information the information related to the updating of the at least one firmware and software is used to verify or authenticate an update of the at least one of firmware

and software ("check that correct data is transferred ... with the data stored in the SUM memory", col. 5, lines 35-39).

Claim 10:

Johansson discloses the device of claim 1 where the removable electronic memory device comprises one of a subscriber identity module (SIM) card, a smart card, an integrated circuit (IC) card, a removable memory card, and a removable memory module (Fig. 1A, item 22).

Claim 12:

Johansson discloses the method of claim 11 where the user removable electronic memory device comprises one of a subscriber identity module (SIM) card, a smart card, an integrated circuit card, a removable memory card, and a removable memory module (Fig. 1A, item 22).

Claim 13:

Johansson discloses the method of claim 11 where the updatable electronic device is a mobile handset (Fig. 1A).

Claim 14:

Johansson discloses the method of claim 11 where the information from the user removable electronic memory device comprises at least one of a signature, a location in a file system, a memory address,, a status flag, and new firmware ("identification data telling ... if the SUM card is designed for upgrading software, adding new features... ", col..4, line 3 – 6).

Claim 15:

Johansson discloses the method of claim 14 where the signature comprises a cyclic redundancy check (CRC) ("checksum or check data area", col. 4, line 8).

Claim 16:

Johansson discloses the method of claim 11 where the metadata information from the user removable electronic memory device comprises an indication of the availability of update information for updating the at least a portion of the at least one of a firmware and software ("identification data telling ... if the SUM card is designed for upgrading software, adding new features... ", col. 4, line 3-6).

Claim 17:

Johansson discloses the method of claim 11 where the information from the user removable electronic memory device is used to verify or authenticate an update of the at least a portion of the at least one of a firmware and software ("check that correct data is transferred ... with the data stored in the SUM memory", col. 5, lines 35 - 39).

Claims 18 -19:

Johansson discloses the method of claim 11 but he does not disclose receiving an update package from a server; and the receiving update information comprising an update package from a server, performed using a wireless network; and the information from the user removable electronic memory device comprises the location of at least one of the update package and the server.

In an analogous and similar configuration, O'Neil discloses updating the client from a server side location as well as performing updates wirelessly (11:30 - 12:10). Therefore, It would have been obvious, to one with ordinary skill in the art at the time the invention was made to combine

Johansson and O'Neil because, it would enable updating the device over a server.

Claim 20:

Johansson discloses the method of claim 11 further including: storing status information in the user removable electronic memory device, if an update was performed; and refraining from storing status information in the user removable electronic memory device, if an update was not performed ("data area that can be altered during or after a complete upgrading procedure", col. 4, lines 9 -14).

Claim 21:

Johansson discloses the method of claim 11 further including: performing at least one of restarting or rebooting the updatable electronic device ("re sets the telephone", col. 6, lines 54-56).

Claim 22:

Johansson discloses the method of claim 21 where at least one of a need to restart or reboot and a type of reboot is resident in the user removable electronic memory device ("If the card installed is not valid ... re sets the telephone", col. 6, lines 52-56).

Claim 23:

Johansson discloses the method of claim 11 where the determining comprises:

verifying whether the retrieved metadata information is at least one of appropriate and authentic ("check that correct data is transferred ... ", col. 5, lines 35 -39) also see [thurston, 0051];

continuing the performance of an update, if the verification is successful; and

executing a normal startup of the updatable electronic device, if the verification is not successful ("activates normal GSM network activities", col. 6, lines 47-48).

Claim 24 and 27:

The updatable electronic device of claim 1, wherein the update information comprises at least one update package (2:35 – 40, see upgrade software).

Claim 25:

The updatable electronic device of claim 1, wherein the metadata the information related to the updating of the at least one of firmware and software comprises information identifying the source of the update information received by the electronic device (5:35 – 40).

Claim 26,

Regarding Claims 26 the updatable electronic device of claim 25, wherein the information identifying the source of the update information comprises a universal resource locator (URL) [Thurston, 0057].

Claim 28:

Regarding claim 28, wherein, downloading the update information from a remote server identified in the user removable electronic memory device [Thurston, 0030-0051].

Claim 29

Regarding Claims 29 the updatable electronic device of claim 25, wherein the information identifying the source of the update information comprises a universal resource locator (URL) [Thurston,0057].

Applicant relies on an assertion of an improper 35 USC 102 rejection to assert an improper motivation argument under '103. However since the '102 rejection is proper as addressed above the 103 rejection is also proper as well.

Response to Arguments

Applicant's arguments with respect to claims 1 – 29 have been considered but are moot in view of the new ground(s) of rejection.

Correspondence information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chuck Kendall whose telephone number is 571-272-3698. The examiner can normally be reached on 10:00 am - 6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Dam can be reached on 571-272-3695. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Chuck O Kendall/

Primary Examiner, Art Unit 2192

